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| COMPANY: | USPTO - Art Unit 2646 | DATE: | 6/28/2006 |
| FAX NUMBER: | 571-273-8300 | TOTAL NO. OF PAGES INCLUDING COVER: | 29 |
| PHONE NUMBER: | | SENDER'S REFERENCE NUMBER: | 7000-285 |
| RE: | Reply Brief | YOUR REFERENCE NUMBER: | 10/647,999 |

☐ URGENT ☐ FOR REVIEW ☐ PLEASE COMMENT ☐ PLEASE REPLY ☐ ORIGINAL TO FOLLOW

NOTES/COMMENTS:

Please find attached the following item(s):

- 1) Reply Brief (28 pages).

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: John H. Yoakum et al.
Serial No. 10/647,999
Filed: 08/26/2003
For: **IP-CENTRIC SPEED DIAL**

Examiner: Briney III, Walter F.
Art Unit: 2615

Mail Stop Appeal Brief – Patents
Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

Sir:

The present **REPLY BRIEF** is filed in response to the Examiner's Answer mailed April 28, 2006. If any fees are required in association with this reply brief, the Director is hereby authorized to charge them to Deposit Account 50-1732, and consider this a petition therefor.

REPLY BRIEF

A. Introduction

The question on appeal is whether claims 1-39 of the present invention are unpatentable under 35 U.S.C. § 103(a) by Strathmeyer et al. (hereinafter "Strathmeyer") in view of Takemoto et al. (hereinafter "Takemoto"). Appellant reiterates its position that Takemoto discloses a speed dial number, which is different than the claimed speed dial code. Notably, there is nothing in Takemoto that indicates the speed dial number is an abbreviated telephone number sequence. As such, Takemoto fails to teach or fairly suggest the use of a speed dial code, as claimed by the Appellant.

In the Examiner's Answer, the Patent Office repeats its rejection from the Office Action of October 31, 2005 (Examiner's Answer, mailed April 28, 2006, pp. 3-10). As Appellant's Appeal Brief adequately addresses the issues raised therein, Appellant focuses this Reply Brief on the Response to Arguments section raised in section (10) of the Examiner's Answer.

Appellant also objects to the introduction of the AT&T All in One Management Features webpage (hereinafter "the AT&T webpage") advanced by the Patent Office in the Examiner's Answer. The introduction of the AT&T webpage at this late date constitutes an impermissible shift in the Patent Office's position, needlessly cluttering the issues before the Board. (MPEP § 1208; see discussion on p. 3). Moreover, the AT&T webpage is irrelevant since it is not indicative of how one of ordinary skill in the art would read the specification and claims of the current invention and the Takemoto reference at the time the invention was made. Even if the AT&T webpage is properly before the Board, the rejection still fails to establish *prima facie* obviousness, as described below.

B. Argument

In the Examiner's Answer, the Patent Office argues that Appellant asserts that the term "speed dial number" only refers to fully stored numbers that are actually dialed over a telephone line, while the term "speed dial code" applies to "abbreviated telephone numbers" and further states that Appellant comes to this conclusion without the basis of reasonable logic or factual support (Examiner's Answer, p. 10). Appellant initially points out that the Patent Office's summary of Appellant's arguments is slightly misleading. To this point, Appellant asserts that the term "speed dial number" refers to the telephone number that is dialed (see discussion on p.

4). With respect to the term “speed dial number,” Appellant previously stated that “Takemoto discloses a speed dial number, which is different than the claimed speed dial code. The speed dial number of Takemoto is a telephone number, which is pre-stored in its entirety in a telephone or facsimile machine. A user action may trigger dialing of the pre-stored number by the telephone or facsimile machine. Notably, there is nothing in Takemoto that indicates the pre-stored number is an abbreviated telephone number sequence.” (Appeal Brief, p. 3). Later, Appellant argued that

“[t]he speed dial number in Takemoto is only mentioned once, and there is no suggestion that the speed dial number is a speed dial code comprising an abbreviated telephone number sequence. In context, the speed dial number of Takemoto is merely a telephone number, which is stored in a telephone or facsimile machine, wherein a user may take some action, such as erasing [sic – “pressing”] a key or entering a code, to have the telephone or facsimile machine automatically dial the full speed dial number. This is the common meaning of a speed dial number. As such, the telephone number dialed is the speed dial number, and not an ‘abbreviated telephone number sequence,’ ”

as otherwise claimed for the term “speed dial code,” as discussed below. (Appeal Brief, pp. 5-6).

Moreover the term “speed dial code” is in the claims and is claimed to comprise “an abbreviated telephone number sequence” that corresponds to an address. An example (12#) is provided in paragraph 0025 of Appellant’s Specification. Thus, the specification and claims of the present invention define the term “speed dial code”. An applicant is entitled to be his own lexicographer and may define a term accordingly. MPEP §2111.01. Appellant has done so here; the term “speed dial code” is “an abbreviated telephone number sequence” that corresponds to an address.

The Patent Office seemingly puts great stock in the newly cited AT&T webpage. The Patent Office supplements its position by relying on the AT&T webpage’s description of speed dialing (Examiner’s Answer mailed April 28, 2006, p. 10). Appellant respectfully traverses the inclusion of the AT&T webpage at this late date. MPEP § 1208 states:

It also frequently happens that an examiner will state a position in the answer in a manner that represents a shift from the position stated in the final rejection without indicating that the last stated position supersedes the former. Such a situation confuses the issue and likewise poses difficulties for the Board since it is not clear exactly what the examiner’s ultimate position is.¹

¹ MPEP § 1208, p. 1200-15, May 2004 edition available at www.uspto.gov.

Appellant respectfully maintains that the addition of the AT&T webpage is a new rejection. The Patent Office has provided no reason why the AT&T webpage could not have been cited prior to the appeal if it was necessary to establish obviousness. Appellant notes that MPEP § 1208 also indicates that a new ground of rejection is no longer permitted in an Examiner's Answer. Since the addition of the AT&T webpage constitutes a new ground of rejection, the use of the AT&T webpage is improper. Appellant requests that the Board reverse the Examiner and instruct the Examiner to allow the claims on this basis.

In addition, even if timely cited, a point Appellant does not concede, the AT&T webpage is irrelevant since it is not prior art and is therefore not indicative of how one of ordinary skill in the art would read the specification and claims of the current invention and the prior art at the time the invention was made. The Patent Office states that the term "speed dial number" is commonly used to refer to an abbreviated telephone number sequence and is analogous to the phrase "speed dial code" (Examiner's Answer mailed April 28, 2006, p. 11) (emphasis added). First, Appellant respectfully submits that the citation to a single webpage nearly three years after the filing date of the present invention hardly constitutes a conclusion that the term "speed dial number" is commonly used to refer to an abbreviated telephone number sequence. To that end, Appellant can cite to prior art references that clearly use the term "speed dial number" to be a telephone number, which is pre-stored in its entirety in a telephone (see, e.g. U.S. Patent 6,947,770 B2 to Rydbeck, col. 10, lines 8-41, attached as Exhibit A; "Cavalier Telephone – Speed Dialing", attached as Exhibit B, which can be found at www.cavtel.com/support/business/featureguides/speeddialing.shtml; and "Lingo VoIP Speed Dial, attached as Exhibit C, which can be found at www.lingo.com/voip/features/speed_dial_voice_over_ip.jsp). Thus, there is support for Appellant's position that the speed dial number is the telephone number that is dialed. The AT&T webpage is therefore irrelevant and misleading. What is relevant is what is claimed by the present invention and what the cited Takemoto reference discloses. Appellant's own specification and claims define the term "speed dial code" to be "an abbreviated telephone number sequence" that corresponds to an address. The question then becomes whether the speed dial number of Takemoto is equivalent to the "speed dial code" of the claims.

The Patent Office opines that Figure 4c of Takemoto depicts both 7 digit telephone numbers and 6 digit speed dial numbers (Examiner's Answer mailed April 28, 2006, p. 11). It is

not clear based on just looking at Figure 4c that the 6 digit numbers shown there are speed dial numbers. The Patent Office cites to paragraphs 0035-0036 of Takemoto as supporting the fact that Figure 4c shows 6 digit speed dial numbers. *Id.* However, paragraphs 0035-0036 never mention speed dial numbers at all. Those paragraphs simply disclose how dial tone signals are detected and converted into a number and then that number is checked versus the facsimile table and the telephone table of Figure 4 to determine whether the message is a facsimile message from the facsimile machine or a telephone call from the telephone. The Patent Office also argues that if only full telephone numbers are received by the control apparatus of Takemoto, there would be no difference in numbers stored within the telephone table. However, as mentioned above, it is not clear based on just looking at Figure 4c that the 6 digit numbers shown are speed dial numbers. The purpose of speed dial codes is to use an abbreviated number sequence in order to save time or where it is difficult to remember the number or address, such as with an IP address (Specification, paragraphs 0004-0006). In light of this, it does not make sense that the 6 digit numbers are speed dial codes since at best they would be only very slightly quicker or easier to remember. Appellant respectfully suggests that the 6 digit numbers are simply fax numbers (note all three examples of the numbers for the fax table are 6 digit numbers) or are 6 digit telephone numbers (some countries use 6 digit telephone numbers, including parts of Japan, where the assignee of the Takemoto reference is based).

In addition, the Patent Office poses the question of why, if only full numbers are stored, does Takemoto even mention storing speed dial numbers (Examiner's Answer mailed April 28, 2006, p. 11). The fact is that Takemoto does not mention storing speed dial numbers. Moreover, the only mention of the term speed dial number in the entire Takemoto reference is in paragraph 0026. If the speed dial number of Takemoto is equivalent to the speed dial code of the claimed invention, one would expect there would be some discussion as to how a speed dial number is assigned to a full telephone number. There is no such disclosure in Takemoto. This is not surprising since the table 15 in Figure 4 is designed to accomplish the primary purpose of Takemoto, which is to determine whether a given transmission is of a telephone or a facsimile, as opposed to the purpose of the claimed invention, which is to use an abbreviated number sequence in order to save time or where it is difficult to remember the number or address, such as with an IP telephone.

In any event, Takemoto does not teach or suggest "accessing an address corresponding to a speed dial code that comprises an abbreviated telephone number sequence" as is required by the claims of the present invention. Further, the Patent Office admits that Strathmeyer fails to disclose a speed dial code that comprises an abbreviated telephone number sequence (Office Action mailed October 31, 2005, p. 3, lines 5-6). Since the combination of Strathmeyer and Takemoto fails to teach or fairly suggest all of the claimed elements, *prima facie* obviousness has not been established. Independent claims 1, 9, 12, 20, 23, 30, and 37 define patentable subject matter. Dependent claims 2-8, 10, 11, 13-19, 21, 22, 24-29, 31-36, 38, and 39 also define patentable subject matter.

E. Conclusion

The Patent Office has not established *prima facie* obviousness for claims 1-39 in light of the Strathmeyer and Takemoto references. Neither reference teaches nor suggests a speed dial code. In addition, the introduction of the AT&T webpage at this late date constitutes an impermissible shift in the Patent Office's position, needlessly cluttering the issues before the Board. Moreover, the AT&T webpage is irrelevant since it is not indicative of how one of ordinary skill in the art would read the specification and claims of the current invention and the Takemoto reference at the time the invention was made. Even if the AT&T webpage is properly before the Board, the rejection still fails to establish *prima facie* obviousness. As such, Appellant requests that the Board reverse the Examiner and instruct the Examiner to allow the claims.

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|---|

Respectfully submitted,

WITHROW & TERRANOVA, P.L.L.C.

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Date: June 28, 2006

Attorney Docket: 7000-285

Exhibit A

Exhibit B



Home Residential Business Customer Care Careers Company

Business Services
 Voice Solutions
 Data Solutions
 Conference Solutions
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 Government Solutions
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 CBC FAQ's
 Testimonials
 Business Care
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Speed Dialing Guide from Cavalier Business Communications

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Allow you to designate one digit codes (between 2 and 9) for your frequently called phone numbers. (Connectiv customers with 30-memory speed dialing, use codes "20" through "49")

Setting speed dial numbers:

1. Press *74 and wait for the dial tone. (Connectiv customers with 30-memory speed dialing press *75 and wait for dial tone)
2. Dial the speed dial code (between 2 and 9, or 20 through 49) that you would like to assign to a particular phone number, then dial the telephone number you wish to enter.
3. Two short tones will confirm your request.
4. When entering a number requiring an area code, you must enter '1' plus the area code, followed by the number.

Changing a speed dial number:

1. Press *74 (or *75 for Connectiv customers) and wait for the dial tone.
2. Dial the code (between 2 and 9, or 20 through 49) of the number you wish to change, then dial the new number.
3. Two short tones will confirm your request.

To place a call using a speed dial:

1. Dial the speed dial code (between 2 and 9) followed by the # key. Connectiv customers with 30-memory speed dial need to press * then the code number you wish to dial, then press # to dial the number.

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Exhibit C



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6/27/2006

Lingo VoIP Speed Dial

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